



PATENT
Customer Number 22,852
Attorney Docket No. 07414.0101-17000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Paul D. Grossman et al.) Group Art Unit: 1637
)
Serial No.: 10/825,074) Examiner: Kenneth R. HORLICK
)
Filed: April 14, 2004) Confirmation No.: 7150
)
For: METHOD FOR DISTINGUISHING)
DIFFERENT SEQUENCE)
POLYNUCLEOTIDES)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Petitioner Applera Corporation, duly organized under the laws of the State of Delaware, and having its principal place of business at 850 Lincoln Centre Drive, Foster City, California, 94404, represents that it is an assignee of the entire right, title and interest in and to the above-identified application, U.S. Patent Application No. 10/825,074, filed April 14, 2004, for Method for Distinguishing Different Sequence Polynucleotides, as indicated by an assignment from PE Corporation (NY) duly recorded in the U.S. Patent and Trademark Office for parent U.S. Patent Application No. 10/167,337, now U.S. Patent No. 6,759,202, at Reel 013367, Frame 0173. PE Corporation (NY) was the sole assignee of parent U.S. Patent No. 5,514,543, which issued from U.S. Patent Application No. 08/102,372 ("the '372 application"), filed August 4, 1993, by a Change of Name Document executed by The Perkin-Elmer Corporation

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and duly recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was the sole assignee of the '372 application by Merger of The Perkin-Elmer Corporation with Applied Biosystems, Inc., duly recorded on March 30, 1995, in the U.S. Patent and Trademark Office at Reel 007408, Frame 0429. Applied Biosystems, Inc. was the sole assignee of the '372 application by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 006846, Frame 0087.

Applera Corporation further represents that it is an assignee of the entire right, title and interest in and to U.S. Patent No. 5,514,543, which issued from U.S. Application No. 08/102,372 ("the '372 application"), as indicated by an assignment from PE Corporation (NY) duly recorded in the U.S. Patent and Trademark Office at Reel 013563, Frame 0534. PE Corporation (NY) was the sole assignee of U.S. Patent No. 5,514,543, by a Change of Name Document executed by The Perkin-Elmer Corporation and duly recorded in the U.S. Patent and Trademark Office at Reel 012676, Frame 0767. The Perkin-Elmer Corporation was the sole assignee of the '372 application by Merger of The Perkin-Elmer Corporation with Applied Biosystems, Inc., duly recorded on March 30, 1995, in the U.S. Patent and Trademark Office at Reel 007408, Frame 0429. Applied Biosystems, Inc. was the sole assignee of the '372 application by an assignment executed by inventors Paul D. Grossman, Steven Fung, Steven M. Menchen, Sam L. Woo, and Emily S. Winn-Deen, and duly recorded in the U.S. Patent and Trademark Office at Reel 006846, Frame 0087.

Applera Corporation, further represents that to the best of its knowledge and belief, title to the above-identified patent application, U.S. Patent Application No. 10/825,074, and U.S. Patent Nos. 5,514,543 and 6,759,202, is in Applera Corporation.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on the above-identified application U.S. Patent Application No. 10/825,074, which would extend beyond the expiration date of U.S. Patent No. 5,514,543, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,514,543, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,074 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 5,514,543, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 5,514,543 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

To obviate a double patenting rejection, Applera Corporation hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on the

above-identified application U.S. Patent Application No. 10/825,074, which would extend beyond the expiration date of U.S. Patent No. 6,759,202, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,759,202, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, the assignee does not disclaim the terminal part of any patent granted on U.S. Patent Application No. 10/825,074 that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of U.S. Patent No. 6,759,202, as presently shortened by any terminal disclaimer, in the event that U.S. Patent No. 6,759,202 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$130.00 is being filed with this disclaimer.

If there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to Deposit Account No. 06-0916. If any further fee and/or petition is required for an extension of time under 37 C.F.R. § 1.136 and is not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916.

The undersigned is authorized to act on behalf of assignee, Applera Corporation.

I hereby declare that all statements made of my own knowledge and belief are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the U.S. Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

4/21/06
Date

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